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SB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/961,084 10/30/97 KRONGAUZ

V 240696

IM22/0608

EXAMINER

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BERMAN, S

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED:

06/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/961,084	Applicant(s) Krongauz et al.
	Examiner Susan Berman	Group Art Unit 1711

Responsive to communication(s) filed on Mar 7, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 19 and 27-50 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 19 and 27-50 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). 15
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Response to Amendment

Claim 27 has been amended to recite “for coating a metal substrate”. This amendment recites a future intended use which is not of patentable weight in the absence of evidence to show that the prior art disclosed compositions are not useful for coating a metal substrate.

Claim 49 has been amended to recite “for coating a conductor”. This amendment recites a future intended use which is not of patentable weight in the absence of evidence to show that the prior art disclosed compositions are not useful for coating a conductor, including a metal conductor.

The claims have been amended to recite that the adhesion promoter is an acidic adhesion promoter or a phosphoric acid “based” adhesion promoter. In response the rejection of record over Mori et al (4,031,066) is hereby withdrawn. Mori et al disclose silane adhesion promoters. The rejections of record over Lee et al (4,786,584) or Krajewski (4,572,610) are also withdrawn because the patents do not teach acidic or phosphoric acid adhesion promoters.

Claim Rejections - 35 USC § 112

Claims 29, 49-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is intended by the phrase “phosphoric acid based adhesion promoter”. In what way is the adhesion promoter “phosphoric acid based”? Is the adhesion promoter phosphoric acid? Is the adhesion promoter a derivative of phosphoric acid and, if so, what kind of

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derivative? Applicant discloses acrylate esters of phosphoric acid on pages 16-17 of the specification.

Claim Rejections - 35 USC § 102 and/or 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19 and 27-50 are rejected under 35 U.S.C. § 103(a) as obvious over EP 0 801 041. EP '041 discloses compositions comprising an acid functional ethylenically unsaturated monomer, which is preferably an ethylenically unsaturated phosphoric acid. See the composition set forth on page 7, lines 43-50, and in Example 4 and Table 2. EP '041 teaches that any conventional coating composition can be modified as taught and that such coating compositions include oligomers based on polyolefins, such as saturated or unsaturated polybutadienes (page 6, lines 36-39).

It would have been obvious to one skilled in the art to include an oligomer based on a polyolefin, such as saturated or unsaturated polybutadiene, in the compositions comprising a polyether urethane acrylate disclosed by EP '041. The reason is that EP '041 teaches that other coating compositions, such as those comprising oligomers based on polyolefins, can be modified by incorporating an ethylenically unsaturated phosphoric acid compound.

With respect to claims 30-32, the properties of the cured coating prepared by radiation curing the claimed composition are considered to be a statement of future intended properties and

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not of any patentable weight in the absence of a showing of unexpected results. See Table 3 for dielectric dissipation factor. See Table 2 for flexibility tests.

With respect to claim 34, aliphatic polyisocyanates are taught in page 5.

Response to Arguments

The claim 27 amendment to recite “for coating a metal substrate” and the claim 49 amendment to recite “for coating a conductor” does not overcome the rejection set forth above. These amendments recite future intended uses which are not of patentable weight in the absence of evidence to show that the prior art disclosed compositions are not useful for coating a metal substrate or a metal conductor. The instant claims are drawn to compositions which are taught within the disclosure of EP ‘041. There is no requirement under 35 USC 103(a) that the prior art teach applicant’s motivation (providing compositions which adhere to metal), as long as the disclosure provides some motivation to arrive at compositions corresponding to those set forth in the instant claims.

Claims 19 and 27-50 are rejected under 35 U.S.C. § 103(a) as obvious over Shustack (5,352,712) in view of EP ‘041.

Shustack discloses coating compositions comprising a hydrocarbon polyol based reactively terminated aliphatic urethane oligomer. See column 9, lines 1-53. Organofunctional silanes are taught as adhesion promoters in columns 14-15. The disclosure of EP ‘041 is discussed above.

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It would have been obvious to one skilled in the art to include an adhesion promoter in the compositions taught by Shustack because Shustack teaches that an adhesion promoter is optional and is required under conditions of high humidity and higher temperature. It would have been obvious to one skilled in the art to employ a strong acid functional ethylenically unsaturated monomer, such as phosphoric acid monoacrylate, as an adhesion promoter in the compositions disclosed by Shustack, as taught by EP '041 in analogous compositions in analogous art. With respect to claims 30-32, the properties of the cured coating prepared by radiation curing the instantly claimed composition set forth are considered to be a statement of future intended properties and not of any patentable weight in the absence of a showing of unexpected results. It would have been obvious to one skilled in the art to determine the optimum weigh percents of components disclosed by Shustack to provide the desired properties in the coatings prepared by curing instantly claimed compositions.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Berman whose telephone number is (703) 308-0040.

The fax number for this group is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Susan Berman

Susan Berman
Primary Examiner
Art Unit 1711

SB
June 5, 2000